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| 10/001,556 | 10/31/2001 | Thomas J. Westbrook | WWWN116621 | 7679 |
| 26389 7590 03/28/2008 CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC 1420 FIFTH AVENUE SUITE 2800 SEATTLE, WA 98101-2347 | | | | |
| EXAMINER | | | | |
| LEVINE, ADAM L | | | | |
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| 3625 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/001,556

Applicant(s)

WESTBROOK ET AL.

Examiner

ADAM LEVINE

Art Unit

3625

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23, 25-29, 32-57 and 68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23, 25-29, 32-57 and 68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 11, 2008, has been entered. It is noted that an advisory action in response to after final amendment was mailed January 16, 2008, and appears to have crossed in the mail with this request for continued examination. The amendments submitted December 26, 2007, were recommended for entry and would in any case have been entered upon the filing of the request for continued examination. There appears to be no consequence of the documents crossing in the mail and no effect on the substance of the present office action.

Response to Amendment

Applicants' amendments and remarks dated December 26, 2007, are responsive to the office action mailed July 23, 2007. Independent claims 1 and 68, and dependent claim 21 are amended. Claim 24 has been cancelled. Claims 1-23,25-29,32-57, and 68 are therefore pending and are considered in this office action.

Response to Arguments

Pertaining to rejection under 102(e) in the previous office action

Applicant's arguments filed December 26, 2007, have been fully considered but they are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "inclusion of additional third party transactions into the completed transaction between a specific buyer and seller") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Upon review of the specification it appears that additional third party transactions are not in fact included into the completed transaction between buyer and seller (a concept that is contradictory to the notion of having completed the transaction), but are rather treated by the method in a series of steps that are related to or affiliated with another completed transaction. The buyer/seller transaction and the third party transaction are still separate transactions. Assuming *arguendo* that this feature were both claimed and not included in the prior art, this would merely represent the repetition of steps in order to achieve the same result. The only thing that would change is the identity of one of the parties to the transaction. It would have been obvious to one having ordinary skill in the art at the time the invention was made to repeat the same steps in order to achieve the same result, since it has been held that mere duplication of

essential parts involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*; 193 USPQ 8, *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

Regardless of the above, however, the prior art also discloses affiliating related third party transactions with the buyer/seller transaction that is the main focus of the method (see at least abstract, figs.6,9; page 7 ¶¶0056-0057, page 8 ¶¶0063-0064, page 9 ¶¶0068,0071-0072, pages 11-12 ¶¶0093-0095. Please note: in addition, while applicant argues that the cited portion of the abstract only teaches a notification component, in disclosing the forwarding of transaction details "to a third-party financial institution for fund transfer," it is actually referring also to the various related agreements that are required by and between both parties and their financial institutions in order to achieve the necessary relationships to enable said funds transfer. Various related agreements with other third parties are disclosed throughout the prior art, in particular with shipping agents and brokers.).

The examiner cites particular pages and paragraphs or columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the claims, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Objections

Claims 25-28 are objected to because of the following informalities: Claims 25-28 depend from claim 24. Claim 24 has been cancelled. It is assumed that claims 25-28 now depend from claim 1 as the features formerly in claim 24 have been incorporated into claim 1. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-23,25-29,32-57, and 68 are rejected under 35 U.S.C. 102(e) as being anticipated by Adam (Paper# 050707; Patent Publication No. 2002/0069156).

Adam teaches all the limitations of claims 1-23,25-29,32-57, and 68. For example, Adam discloses a method for facilitating transactions between one or more buyers and sellers. Adam further discloses:

- Obtaining a buyer transaction request: the transaction request including one or more buyer criteria embodied in one of three classifications including general classifications, specific seller and combination general classification and specific

seller, obtaining a third party transaction request (see at least abstract, page 6 ¶¶0048, page 7 ¶¶0053-0054, page 8 ¶0064, page 9 ¶0071); obtaining the buyer transaction request includes obtaining a buyer transaction inquiry from a buyer computing device, wherein the buyer transaction inquiry includes a request to identify sellers operable to sell a buyer specified product and quantity (see at least abstract); includes obtaining a buyer transaction query from a buyer computing device, wherein the buyer transaction query includes an invitation for offers from a number of sellers (see at least abstract, page 6 ¶0048, page 7 ¶¶0053-0054, page 8 ¶0064, page 9 ¶0071); transaction request is obtained from the buyer (see at least abstract); transaction request is a products transaction request (see at least abstract. Please note: the type of product being bought and sold is not functionally involved in the recited steps of the method, thus the specific term "wood" that describes a product is not functionally involved in the recited steps of the method. Because it has no functional role in the method it is non-functional descriptive material. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). The method is the same regardless of the product sold.)

- Identifying a set of sellers corresponding to the at least one buyer criteria: based upon seller provided information (see at least abstract, figs.5-6, page 1 ¶¶0005-0006, page 4 ¶0032, page 7 ¶0053); identifying one or more third parties corresponding to third party transaction request (see at least abstract, page 6

¶0048, page 7 ¶¶0053-0054,0056-0057, page 8 ¶¶0063-0064, page 9

¶¶0068,0071-0072, page 10 ¶¶0078-0082, pages 11-12 ¶¶0093-0095);

identifying a set of sellers corresponding to the buyer criteria includes obtaining product and quantity correlation data and translating the buyer specified product and quantity data into a format compatible with each identified seller corresponding to the buyer criteria (see at least figs.4-6); identifying a set of seller corresponding to the buyer criteria includes applying selection criteria (see at least page 10 ¶¶0078-0082); selection criterion includes information: selecting one or more general seller categories to include/exclude, identifying specific sellers to include/exclude (see at least page 10 ¶0078), identifying one or more general seller categories to include/exclude and one or more specific sellers corresponding to the general seller categories to include/exclude (see at least page 9 ¶0071); information identifying specific sellers to include/exclude is obtained from the buyer computing device, seller computing device (see at least page 10 ¶0078); identifying a set of sellers corresponding to the buyer criteria includes transmitting the transaction query to the set of sellers and obtaining one or more seller offers corresponding to the transaction query (see at least figs.4-6); applying selection criteria (see at least page 10 ¶¶0078-0082); selection criterion includes information selecting one or more general seller categories to include/exclude from the transaction query, information obtained from the buyer computing device identifying specific sellers to include/exclude from the

transaction query, obtained from a seller computing device (see at least page 9 ¶¶0071 and page 10 ¶¶0078); selection criterion includes information identifying one or more general seller categories to include/exclude and one or more specific sellers corresponding to the general seller categories to include/exclude (see at least ¶¶0071 and ¶¶0078);

- Transmitting the set of sellers corresponding to the buyer criteria: transmitting a set of third parties corresponding to the third party transaction request (see at least abstract, page 10 ¶¶0078-0082);
- Obtaining a selection of at least one seller corresponding to the buyer criteria: obtaining a selection of at least one third party corresponding to the third party transaction request (see at least abstract, page 10 ¶¶0078-0082); generating a Web page interface and obtaining a selection of the at least one seller via the Web page interface, graphical user interface (see at least page 5 ¶¶0044); transaction request is obtained from the selected seller (see at least abstract);
- Processing the negotiation of a transaction: between the buyer and the selected seller corresponding to the buyer criteria, processing the negotiation of a transaction with the selected third party corresponding to the third party transaction request (see at least abstract, page 10 ¶¶0078-0082); obtaining communications from the buyer and transmitting the communications to the selected seller (see at least abstract); obtaining communications from the selected seller and transmitting the communications to the buyer (see at least abstract); obtaining a selection of a direct communication method between the

buyer and the selected seller and establishing the direct communication channel between the buyer and the selected seller (see at least page 3 ¶0025); direct communication channel includes an Internet voice communication channel, a standard telephonic communication channel (see at least page 5 ¶0039);

- Obtaining a confirmation of the completion of a transaction: between the buyer and the selected seller, obtaining a confirmation of the completion of a transaction with the selected third party corresponding to the third party transaction request, processing the completion of a transaction wherein completion includes an agreement as to terms (see at least abstract, page 1 ¶0008, page 2 ¶0014, page 9 ¶0068, page 12 ¶0095);
- Generating transaction records: associated with the completed transaction (see at least abstract, page 9 ¶0073); transaction details are forwarded to a third-party (see at least abstract. Please note: The descriptive material related to the type of third-party is not functionally involved in the recited steps of the method. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381 , 1385, 217 USPQ 401, 404 (Fed. Cir. 1983)).

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the

application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **ADAM LEVINE** whose telephone number is (571)272-8122. The examiner can normally be reached on M-F, 8:30-5:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571.272.6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Adam Levine
Patent Examiner
March 25, 2008

/Yogesh C Garg/
Primary Examiner, Art Unit 3625